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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,037	04/02/2004	Richard Lacey	59-29-101	2252

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EXAMINER

LEADER, WILLIAM T

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/817,037	Applicant(s) LACEY, RICHARD	
	Examiner William T. Leader	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Page 11, line 7 includes extraneous symbols and blank underlining. Any amendment of the specification must avoid the introduction of new matter.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Applicant's claims include the expression "electroplating solution". Claims 8 and 14 recite that the electroplating solution consists of water, oxalic acid, trisodium phosphate and ammonium sulfate. By using the transitional phrase "consisting of" claims 8 and 14 excludes all constituents other than those specifically recited. An electroplating solution is generally construed in the art to be a solution from which the electroplating of metal may be performed. As such, it is recognized that the solution must contain a source of the metal or metals being deposited. See

the Lowenheim text *Electroplating*, page 120. In discussing the ingredients of an electroplating bath, Lowenheim states that "Obviously the bath must contain the metal to be deposited." By excluding the metal from the solution of claims 8 and 14, applicant appears to be using the expression "electroplating solution" in a manner contrary to that accepted in the art. It appears necessary for applicant to recite the metal or metals to be plated as a part of applicant's "electroplating solution". Claim 15 also appears to recite the use of a solution called an electroplating solution which is free of plating metal. Since the scope of the expression "electroplating solution" is not clear, and this expression is included in all of the claims, the scope of all claims is considered to be indefinite.

Claim 18 contains the trademark/trade name "monel". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to

identify/describe the metal from which the article is made and, accordingly, the identification/description is indefinite.

5. Hackh's Chemical Dictionary, fourth edition, identifies "Monel" as a trademark for a native alloy containing normally Ni 67, Cu 28, Mn 1-2, Fe 1.9-2.5 wt %. See page 436.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Charrier (3,642,588).

8. The Charrier patent is directed to compositions for acid electroplating baths. Bath number 5 in section D "zinc plating" (column 5, lines 58-63) comprises ammonium oxalate, dibasic potassium phosphate, and ammonium sulfate. All constituents recited in instant claim 1 are disclosed by Carrier. With respect to claim 10, Charrier additionally discloses that it is known to use a soluble metal anode in an electroplating process, and that the soluble anode permits a current

density of 5 to 10 a/dm² (column 4, lines 6-8). This shows that a current is passed as recited in claim 10.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charrier in view of the Lowenheim text *Electroplating*.

11. Claim 16 recites that the plating metal anode and the article are at least partly immersed in a bath of the solution. Charrier is silent as to whether the anode and article are immersed. The Lowenheim text shows that it is conventional to place the electroplating solution in a plating tank. A typical tank is shown in Fig. 8-2. The anodes and workpiece are immersed in the tank. See pages 116 and 117.

12. The prior art is indicative of the level of skill of one of ordinary skill in the art. It would have been obvious at the time the invention was made to have immersed the anode and article in an electroplating bath in the process of Charrier because Lowenheim shows that this is the manner in which electroplating is conventionally carried out.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charrier in view of the Metal Finishing Guidebook and Directory.

14. Claim 17 recites that the plating anode is at least partly covered with a layer of an absorbent material and plating solution is absorbed into the material. Metal Finishing discloses that brush plating is a technique whereby localized plating of parts is possible without immersing them in a plating bath. The process possesses advantages such as permitting repair of hardware without disassembly (page 395). As shown in the figure on page 396, absorbent cotton is placed around the anode. It would have been obvious at the time the invention was made to have utilized brush plating in the process of Charrier because immersion of the workpiece would have been avoided and selected areas of the workpiece could have easily been plated.

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wakui et al (5,470,636).

16. The Wakui et al patent is directed to a method of producing a recording medium. An aluminum base is anodized to produce a porous surface and a metal such as copper is electrodeposited into the pores. The surface is treated with a solution which contains one, two or more constituents selected from groups which includes oxalic acid, trisodium phosphate, and ammonium sulfate. See column 7,

line 35 to column 8, line 3. Choice of constituents from those listed by Wakui et al to form an aqueous solution would have been obvious.

Allowable Subject Matter

17. Claims 3-9, 11-13 and 18-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art of record does not suggest an electroplating solution comprising oxalic acid, trisodium phosphate and ammonium sulfate in the ratios recited in these claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 571-272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WL

William Leader
August 30, 2004

RK

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700